

Remarks

The Office Action of February 17, 2005 has been carefully considered.

Reconsideration of this application is respectfully requested as the claims 1-12, 14-19 and 21 are believed to be in condition for allowance. A one-month extension of time is provided herewith. The Examiner in the office action of February 17, 2005 alleged that the amendment filed on December 10, 2004 did not attempt to point out patentable novelty. In response, Applicant respectfully submits specific reasons of patentability for each of claims 1-12, 14-19 and 21.

In embodiments, provided are various methods of ordering a part which as claimed as a whole provide beneficial efficiency and security. With respect to the claims 1-12, 14-19 and 21, the previous rejections are not sustainable as the PTO has not established a prima facie case of obviousness nor have the rejections shown each and every feature of the invention as claimed. Moreover, hindsight analysis is not permitted.

For claim 1, there is no teaching, suggestion or motivation for a method of ordering a part of an apparatus including the combination of: monitoring electronically a condition of a replaceable part in a first device, the replaceable part having: a first condition upon installation; at least one intermediate condition after use; and a third condition when a replacement part is substantially necessary; launching an electronic communication link to a URL address of a computer, the URL address defined by a condition of the replaceable part; electronically sending a signal to a second device, the signal automatically electronically offering to purchase a replaceable part upon identification of at least one of the first condition, second condition, and third condition in the replaceable part; and sending a digital electronic signature associated with the offering to purchase the replaceable part, as a whole, as recited in amended independent claim 1. Claims 2-12 and 21 depend directly or indirectly from amended independent claim 1 and are allowable for the same

reason and on their own merits as they recite other features neither taught nor suggested by the previously applied references.

Claim 2 depends from amended independent claim 1 and is allowable for the same reason stated for claim 1 and for the reason that claim 2 further provides predicting a condition of the part prior to the electronically sending the signal. Claim 2 is to be examined as a whole.

Claim 3 depends indirectly from amended independent claim 1 and is allowable for the same reasons stated for claim 1 and for claim 2 and for the reason that claim 3 further provides receiving electronically an acceptance of the offer to purchase the replaceable part. Claim 3 is to be examined as a whole.

Claim 4 depends indirectly from amended independent claim 1 and is allowable for the same reasons stated for claim 1 and for claim 2 and for claim 3 and for the reason that claim 4 further provides installing the replaceable part prior to occurrence of the third condition. Claim 4 is to be examined as a whole.

Claim 5 depends indirectly from amended independent claim 1 and is allowable for the same reasons stated for claim 1 and for claim 2 and for claim 3 and for the reason that claim 5 further provides delivering the replaceable part to the first device when monitoring indicates the condition of the part is between about the first condition and the third condition. The claims are examined as a whole. Claim 5 is to be examined as a whole.

Claim 6 depends indirectly from amended independent claim 1 and is allowable for the same reasons stated for claim 1 and for claim 2 and for claim 3 and for the reason that claim 6 further includes providing information relating to the signal to at least one of a user, a supplier, and a third party. Claim 6 is to be examined as a whole.

Claim 7 depends indirectly from amended independent claim 1 and is allowable for the same reasons stated for claim 1 and for claim 2 and for claim 3 and for claim 6 and for the reason that claim 7 further includes that the information relates to at least one of: (1) a present condition of the part; (2) a prediction of a future condition of the part; (3) an inquiry; and (4) an offer to purchase. Claim 7 is to be examined as a whole.

Claim 8 depends from amended independent claim 1 and is allowable for the same reason stated for claim 1 and for the reason that claim 8 further provides using a sensor and software system to perform monitoring and predicting of a condition of the part. Claim 8 is to be examined as a whole.

Claim 9 depends from amended independent claim 1 and is allowable for the same reason stated for claim 1 and for the reason that claim 9 further provides that the first device is interactive. Claim 10 is to be examined as a whole.

Claim 10 depends from amended independent claim 1 and is allowable for the same reason stated for claim 1 and for the reason that claim 10 further provides displaying a purchase order screen including data relating to the part automatically filled out on the purchase order screen based on an identified condition; and sending the data electronically to a supplier of the part after personal information data is automatically entered by an application program into the purchase order screen. Claim 10 is to be examined as a whole.

Claim 11 depends indirectly from amended independent claim 1 and is allowable for the same reasons stated for claim 1 and claim 10 and for the reason that claim 10 further provides sending data to the supplier after a user enters data. Claim 11 is to be examined as a whole.

Claim 12 depends indirectly from amended independent claim 1 and is allowable for the same reason stated for claim 1 and claim 2 and claim 3 and claim 6 and for the reason that claim 12 further provides that the information further relates to at least one of: (1) present supply of a consumable; (2) wear of a consumable; (3) usage of the part; (4) rate of depletion of a consumable; (5) rate of wear of the consumable; (6) predicted date of depletion of the consumable; (7) a predicted date of need of a consumable; (8) delivery schedule of a consumable; and (9) statistical data relating to a part. Claim 12 is to be examined as a whole.

Claim 21 depends from amended independent claim 1 and is allowable for the same reason stated for claim 1 and for the reason that claim 21

further provides that the electronically sending of the signal to the second device is a wireless communication. Claim 21 is to be examined as a whole.

For claim 14, there is no teaching, suggestion or motivation for a method of ordering a part of an apparatus including the combination of: identifying electronically a condition in an apparatus; automatically launching an electronic communications to initiate at least one of an inquiry and an offer to purchase based on the condition to a URL address of a computer associated with a condition of the part, the URL address defined by a condition of the part; displaying a purchase order screen including a part number automatically filled out on the purchase order screen based on the identified condition; sending an electronic purchase order for the part using the URL address of a computer associated with the condition of the part; and sending a digital electronic signature associated with the electronic purchase order, as a whole, as recited in amended independent claim 14.

For claim 15, there is no teaching, suggestion or motivation for a method of ordering a part for a marking device including the combination of: sensing a condition of a part in a marking device, the marking device adapted to predict a code indicative of a threshold of a consumable in the part; launching an electronic communication to a URL address of a computer associated with a condition of the part, the URL address defined by a condition of the replaceable part; sending an electronic purchase offer for a replacement of the consumable part using at least one of the URL address of the computer associated with a condition of the part and a derivative of the URL address associated with the condition of the part; and sending a digital electronic signature associated with the electronic purchase offer, as a whole, as recited in amended independent claim 15. Claim 16 depends from amended independent claim 15 and is allowable for the same reason and on its own merits as it recites other features neither taught nor suggested by the previously applied references.

Claim 16 depends from amended independent claim 15 and is allowable for the same reason stated for claim 15 and for the reason that claim 16 further provides that the consumable part is functionally associated with a

sensor and software system to sense and predict a condition in the device and to electronically communicate information, the sensor and software system including logic adapted to initiate a purchase order defined by the condition. Claim 16 is to be examined as a whole.

For claim 17, there is no teaching, suggestion or motivation for a method of ordering a part of an imaging apparatus including the combination of: identifying electronically a condition in a consumable part, the consumable part having a first condition upon installation, at least one intermediate condition after use, and a third condition when a replacement of the consumable part is substantially necessary; and using a software and sensor system associated with the apparatus to at least one of: (a) electronically monitor the condition of the consumable part; (b) electronically predict the condition of the consumable part; and after at least one of (a) and (b); (c) automatically launch a communication to a URL address of a computer associated with a condition of the consumable part upon at least one of an occurrence and a prediction of at least one of the first condition, intermediate condition, and third condition, the URL address defined by a condition of the part; sending at least one of an inquiry and an offer to purchase a replacement of the consumable part using at least one of the URL address of the computer associated with a condition of the part and a derivative of the URL address associated with the condition of the part; and sending a digital electronic signature associated with at least one of the inquiry and the offer to purchase, as a whole, as recited in amended independent claim 17. Claims 18-19 depend from amended independent claim 17 and are allowable for the same reason and on their own merits as they recite other features neither taught nor suggested by the previously applied references.

Claim 18 depends from amended independent claim 17 and is allowable for the same reason stated for claim 17 and for the reason that claim 18 further provides receiving electronically an acceptance of the offer to purchase. Claim 18 is to be examined as a whole.

Claim 19 depends from amended independent claim 17 and is allowable for the same reason stated for claim 17 and for the reason that claim

19 further provides that the communication further relates to at least one of: (1) present supply of a consumable; (2) wear of a consumable; (3) usage of the part; (4) rate of depletion of a consumable; (5) rate of wear of the consumable; (6) predicted date of depletion of the consumable; (7) a predicted date of need of a consumable; (8) delivery schedule of a consumable; and (9) statistical data relating to a part. Claim 19 is to be examined as a whole.

In summary, Applicants respectfully submit that there is provided in the claims 1-12, 14-19 and 21, each as a whole, improved methods for ordering a part not disclosed or suggested in the previous cited references. Each of the claims 1-12, 14-19 and 21 are believed patentable. The PTO has not shown an objective teaching in the prior art or an objective teaching in knowledge generally available to one of ordinary skill in the art that would lead to combine the relevant teachings of the references. Accordingly, there is no anticipation or a *prima facie* case of obviousness for the reasons as indicated herein.

Furthermore, the claim limitations together, as a whole, have meaning as recited in the amended independent claims 1, 14, 15, and 17 and their respective dependant claims. The PTO has not established anticipation or a *prima facie* case of obviousness with respect to these entire independent claims or each of their respective dependent claims as recited in combination.

Conclusion

It is respectfully requested that the Examiner withdraw the rejections of these pending claims 1-12, 14-19 and 21 and to allow this application.

No additional fee is believed to be required for this Amendment, however, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is requested to call Applicant's attorney, Andrew D. Ryan, at telephone number (585) 422-8085, Rochester, New York.

Respectfully submitted,

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